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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/659,375	09/08/00	TAKAHASHI	1539.1002 RE

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MM92/0529

EXAMINER
HENRY, J

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 05/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/659,375

Applicant(s)

TAKAHASHI, TOMOWAKI

Examiner

Jon W. Henry

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 13, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION***Reissue Applications***

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See *In re Weiler*, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986).

Applicant asserts in item no. 7 of the declaration filed November 21, 2000, an error drafting claims 1 and 10 of the patent unduly narrowly, which error has been corrected in at least claim 27. However, claim 27, as well as all the other newly presented independent claims, are also narrower than any patent claims by at least the recitation of "dioptric" and none of the claims newly presented in reissue are purely narrower than any of the patent claims. That is, all newly presented claims include separate features from all of the patent claims. Additionally, no linking claim, allowable or otherwise, has been presented to indicate the inventions claimed in the patent have unity of invention with the inventions claimed in the claims newly presented in reissue. In fact, it appears the patentability of the claims newly presented in reissue and the patent claims, if any, is related to the separate features of the inventions. The fact the common subject matter of the patent claims and claims newly presented in reissue do not appear to relate to an unclaimed allowable linking claim directed to the newly claimed subject matter minus the recitation of "dioptric" is emphasized by reference to the Fig. 7 embodiment of Suenaga et al that may anticipate or at least make obvious such subject matter newly claimed in reissue "but for" the recitation of "dioptric." Therefore, it appears the claims newly presented in reissue relate to subject matter "entirely distinct" from anything earlier claimed or attempted or intended to be claimed. See *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 675 (Fed. Cir. 1986).

Art Unit: 2872

Additionally, the original patent claims have not been changed at all, and therefore it appears any statutory error would have to relate to the claims newly presented in reissue.

Applicant's statements in his declaration, including item no. 7, do not address how (1) the inventions newly claimed in reissue are not directed to "entirely distinct" inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (2) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but *Weiler* is not controlling case law in this instance. Therefore, it appears applicants' declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

Claims 1-57 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above.

Response to Arguments

2. Applicant argues "C. the Declaration Relies Upon An Error For Which A Reissue Application Can Be Granted Since New Claims are Broader Than Original Patent Claims" on pages 5-8 of applicant's response. Applicant's remarks, with reference to MPEP 1412.03, note that a claim submitted for reissue is considered broader than a patent claim if it is broader in any respect. Those remarks are essentially irrelevant to the issues of a defective declaration in this reissue application.

The issues in this application relate to "entirely distinct" inventions, not merely to claims that are broader in some respect. MPEP 1412.03 recites nothing to indicate an applicant is always entitled to broadened reissue claims. Additionally, the issues in this application concern

Art Unit: 2872

what is considered statutory error under 35 USC 251. The statute clearly controls in this instance and proper statutory interpretation clearly supercedes whatever applicant may attempt to attribute to the MPEP. "Of course, an agency's interpretation of a statute it administers is entitled to deference...but 'the courts are the final authorities on issues of statutory construction. They must reject administrative constructions of the statute, whether reached by adjudication of by rulemaking, that are inconsistent with the statutory mandate of that frustrate the policy that Congress sought to implement.'" *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154, (Fed. Cir. 1988) (quoting *Federal Election Comm'n v. Democratic Senatorial Campaign Comm.*, 445 U.S. 27, 32 (1981)). Therefore, whatever applicant may attribute to MPEP 1412.03 cannot supercede *Weiler*.

Applicant argues "D. The Declaration Relies Upon An Error For Which a Reissue Application Can Be Granted Since New Claims are Supported By The Existing Specification" on pages 8-10 of applicant's response. *Weiler* clearly refuted that argument with regard to claims 13 and 19, the only claims on appeal in *Weiler*, as follows: "Weiler's argument that the subject matter of claims 13 and 19 does not constitute 'an independent and distinct invention' merely because that subject matter can be found somewhere in the overall disclosure of the '923 patent is meaningless...the subject matter must have been disclosed, § 112, or there is no basis for discussing whether the invention being claimed on reissue is independent or distinct." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 676 (Fed. Cir. 1986).

Applicant's remarks, page 9, lines 5-12, that the fact a restriction requirement had been made in the prosecution of the original patent to Weiler et al determined the outcome in *Weiler* is logically in error. The court in *Weiler* did state various relationships of distinctness: "The subject

Art Unit: 2872

matter of [appealed claims] 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 676 (Fed. Cir. 1986). However, the court and the parties in *Weiler* understood the issue was whether the claims on appeal were "independent and distinct" from the patent claims: "Weiler says the subject matter of neither claim 13 nor claim 19 constitutes 'an independent and distinct invention' from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 675 (Fed. Cir. 1986).

It was, of course, the separate features of the patent claims and the claims on appeal that determined the inventions were "independent and distinct." However, the court did not state the rule of the case in terms of "independent and distinct" inventions but rather in terms of "entirely distinct" inventions. "The board's language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 675 (Fed. Cir. 1986). Additionally, the court in *Weiler* identified the part of statutory provision of 35 USC 251 at issue was statutory error, not sufficiency of disclosure under 35 USC 112, first paragraph. "Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established 'error' which can be remedied by reissue." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 677 (Fed. Cir. 1986).

Art Unit: 2872

Additionally, it was not only the "independent and distinct" aspect of the reissue claims that the court weighed in finding lack of statutory error. The court also stated: "Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did, of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an appellant point out and distinct claim subject matter he regards as his invention. 35 U.S.C. § 112, 2d ¶.2" *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 676 (Fed. Cir. 1986). The requirements of 35 USC 112, second paragraph, also weigh against finding statutory error in the instant application.

Furthermore, the court associated its refusal to find statutory error in newly claiming an entirely distinct invention in reissue to another part of the reissue statute. "Moreover, § 251 authorizes reissue for 'the' invention disclosed in the original patent, not for just 'any' and 'every' invention for which one may find some support in the disclosure of the original patent." *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 676 (Fed. Cir. 1986). The court's interpretation of that part of the reissue statute also applies equally well to the instant application.

In spite of the clarity of the decision in *Weiler*, applicant at least suggests, page 9, lines 12-18, that a later court case, *In re Amos*, 21 USPQ2d 1271 (Fed. Cir. 1991), "limited *In re Weiler*, et al." that is, overruled *Weiler*, by allowing reissue to always extend to the 35 USC §112, first paragraph, bounds of an original patent disclosure. Applicant's comments totally ignore the fact that *Amos* did not concern issues of "independent and distinct" inventions, "entirely distinct" inventions, patentably distinct inventions, or any similar issues that might be considered relevant in determining if the declaration in this reissue application is sufficient. In

Art Unit: 2872

fact, the court in Amos clarified it was not making any new law but was merely reiterating case law set forth before Weiler (and therefore logically could not define any new limitation on Weiler as applicant asserts): "Our decision in this circumstance is dictated by this Court's previous decision in In re Hounsfield, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983). [footnote 3 to be discussed presently]... Thus, we conclude, as did this Court in Hounsfield, that the presence of absence of an objective intent to claim, standing alone, is simply not dispositive of any required inquiry under § 251." In re Amos, 953 F.2d 613, ___, 21 USPQ2d 1271, 1276 (Fed. Circuit. 1991). Therefore, it is clear Amos did not "limit," "overrule," or, in fact, affect the decision in Weiler in any way.

Furthermore, the court in Amos, in footnote 3, went to extraordinary lengths to assure the decision in Amos would not be misconstrued in any manner as limiting or overruling Weiler:

Footnote 3. Neither party nor the Board cited or discussed this case [Hounsfield]. Inexplicably, all three rely instead on dicta from Weiler. The issue for decision in Weiler was whether the patentee had demonstrated error without deceptive intention, not whether the claims were to the same invention as the "original patent." We do not quibble with the holding in Weiler that satisfaction of the § 112 ¶ 1 written description requirement does not establish "error" with § 251. Weiler, 790 F.2d at 1581 n. 2, 229 USPQ 676 n.2. Weiler did not involve the question of whether § 112 ¶ 1 speaks conclusively to the "original patent" requirement of § 251... We have no ready explanation for the Board's or the parties' attention to Weiler and

Art Unit: 2872

utter inattention to *Hounsfield*. (*In re Amos*, 953 F.2d 613, 619, 21

USPQ2d 1271, 1276 (Fed. Cir. 1991)).

Despite that admonition of the court in *Amos*, applicant apparently would prefer to pretend it does not exist and conclude *Amos* sub silentio overruled *Weiler*.

Even further, even if one were to assume *Amos* overruled *Weiler*, because, according to the court in *Amos*, *Amos* merely reiterated the law of *Hounsfield*, one would have to conclude that the court in *Weiler* was either unaware of *Hounsfield* or erroneously overruled *Hounsfield*. However, the decision in *Weiler* clearly refutes either of those possibilities by specifically citing *Hounsfield* and explaining *Hounsfield* concerned not the statutory error issue of *Weiler*, and of the instant application, but the issue of “intent to claim” that relates merely to a threshold issue of finding “statutory error” in terms of the reissue claims having 35 USC 112, first paragraph, support in the original application. *In re Weiler*, 790 F.2d 1581, ___, 229 USPQ 673, 677 (Fed. Cir. 1986).

In view of (a) applicant’s failure to explain why *Weiler* is not controlling case law in this application in terms of how (1) the inventions newly claimed in reissue are not directed to “entirely distinct” inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (2) the inventions newly claimed in reissue are directed to “entirely distinct” inventions but *Weiler* is not controlling case law in this instance, and (b) the factors considered in *Weiler* in determining insufficiency of the reissue declaration weigh similarly in determining insufficiency of the reissue declaration in this application, the examiner must reject claims 1-57 as being based upon a defective reissue declaration under 35 USC 251 as set forth above.

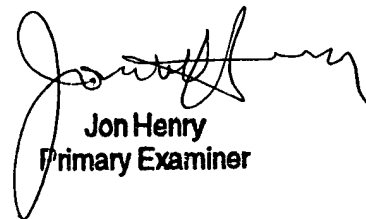
Art Unit: 2872

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.


Jon Henry
Primary Examiner